

## **REMARKS**

### ***Status of the Claims***

Claims 1-19 are pending in the application. Claims 1-19 stand rejected. Reconsideration and allowance of all of the pending claims are respectfully requested.

### ***Claim Rejections – 35 U.S.C. § 103***

Claims 1-19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sanada et al. '275 (US 2003/0195275) in view of Wider et al. '334 (U.S. Patent No. 6,071,334). Applicants respectfully traverse this rejection for the following reasons.

Relevant to this § 103(a) rejection, *Graham v. John Deere*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966) has provided the controlling framework for an obviousness analysis, wherein a proper analysis under § 103(a) requires consideration of the four *Graham* factors. One such factor includes the evaluation of any evidence of secondary considerations (e.g., commercial success; unexpected results). 383 U.S. at 17, 148 USPQ at 467. In this regard, Applicants respectfully submit that the present invention has achieved unexpected results, whereby such results rebut any asserted *prima facie* case of obviousness. See *In re Corkill*, 711 F.2d 1496, 226 USPQ 1005 (Fed. Cir. 1985). Also, the comparative showing need not compare the claimed invention with all of the cited prior art, but only with the closest prior art. See M.P.E.P. §§ 716.02(b) and 716.02(e).

In this regard, Applicants note MPEP 2144.08(5)(B), which states that rebuttal evidence and arguments can be presented in the specification, *In re Soni*, 54 F.3d 746, 750, 34 USPQ2d 1684, 1687 (Fed. Cir. 1995).

One of the features of the ink composition of the present invention is that the composition comprises the compound represented by the formula (I). The compound of the formula (I) provides an ink with a property making the ink hard to foam as well as good application properties with respect to members of a printer nozzle. As a result, even if foams are generated in the ink, they are relatively prone to disappear to ensure stable ink feed in high speed printing. Furthermore, the composition has the effect of accelerating the permeation of the ink into paper in printing on a medium, especially on ordinary paper (see page 6, lines 2-9 of the present specification).

Thus, due to the unexpected results as achieved by the present invention, this rejection has been overcome. Reconsideration and withdrawal of this rejection are respectfully requested.

Moreover, the Examiner appears to find that the compound of the formula (I) of the present invention is included in the five surfactants described in paragraphs [0018]-[0022] of Sanada et al. '275. However, the compound of the formula (I) of the present invention and the five surfactants of Sanada et al. '275 have different structures. Applicants have carefully compared formula (I) of the present invention with the surfactants described in paragraphs [0018] – [0022] of Sanada et al. '275. It is Applicants' position that none of the surfactants fall within the scope of formula (I). The closest surfactant may be the surfactant of Formula (5) described in paragraphs [0022], [0033] and [0087]. However, there are several differences between this surfactant and formula (I) as summarized below.

<b><u>Formula (I)</u></b>	<b><u>Formula (5)</u></b>
present invention	Sanada et al. '275
one –OH group	two –OH groups
branched structure	linear structure
(CH <sub>2</sub> CH <sub>2</sub> CH <sub>2</sub> O) groups at end of molecule	(C <sub>3</sub> H <sub>6</sub> O) groups not at end of molecule
m, n, m+n, X, and Y all defined	a, b, and c are positive integers with no upper limit

If the Examiner is of the opinion that Applicants have overlooked any specific relevant teachings of Sanada et al. '275, the Examiner is requested to specifically point out the relevant teachings of Sanada et al. '275.

Because Sanada et al. '275 do not describe the compound of the formula (I), Sanada et al. '275 do not suggest that the compound of the formula (I) of the claimed invention gives the above-described effect to an ink composition.

In addition, pages 10 and 11 of the present specification describe the compounds (a) to (d) as compounds that can be added to the ink composition in addition to the compound of the formula (I). The compounds of the formulae (a) and (d) are the same as the surfactants of paragraphs [0021] and [0022] of Sanada et al. '275. The compounds of the formulae (b) and (c) are included in the surfactant of paragraph [0018] of Sanada et al. '275. The description at pages 10-11 of the present specification indicates that the present invention comprises the compound of the formula (I), which is different from the five surfactants of Sanada et al. '275.

To establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. (See MPEP 2143.03). As discussed above, the combination of references fails to teach or suggest all the claim limitations of independent claim 1, and those claims dependent thereon. Therefore, a *prima facie* case of obviousness has not been established, and withdrawal of the instant rejection is respectfully requested.

In summary, the present invention produces the above-described effect, which is not suggested by Sanada et al. '275, by the ink composition comprising the compound of the formula (I), which is not described by Sanada et al. '275. Applicants further submit that Wider et al. '334 do not overcome these deficiencies and do not disclose or suggest the compound represented by formula (I) of claim 1. The Examiner has not suggested that Wider et al. '334 describe compounds of the formula (I). Thus, neither Sanada et al. '275 nor Wider et al. '334 disclose the

compound of formula (I) as defined in claim 1 of the present application. Therefore, even if these two references are combined with each other, they do not teach or suggest the present invention.

Accordingly, Applicants respectfully submit that the pending rejection must be withdrawn since claims 1-19 clearly distinguish over the cited prior art. An early reconsideration and Notice of Allowance are respectfully requested.

#### Conclusion

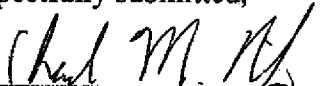
In view of the above remarks, Applicants believe the pending application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Chad M. Rink, Reg. No. 58,258 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Dated: September 17, 2008

Respectfully submitted,

By  #58,258  
for Gerald M. Murphy, Jr.  
Registration No.: 28,977  
BIRCH, STEWART, KOLASCH & BIRCH, LLP  
8110 Gatehouse Road  
Suite 100 East  
P.O. Box 747  
Falls Church, Virginia 22040-0747  
(703) 205-8000  
Attorney for Applicants